

SN. 10/647,094

ATTORNEY DOCKET NO. FUJI:270

REMARKS

Applicant requests non-entry of the Amendment after Final filed on 12 September 2005.

Claims 4, 7-14, 16, and 18-20 remain pending in this application for which applicant seeks reconsideration.

Amendment

The present amendment is identical to the unentered Amendment after Final filed on 12 September 2005, except for the phrase "consisting essentially of," which now has been changed to --consisting of--. As claim 1 has been canceled, the § 112 rejection has been rendered moot. No new matter has been introduced.

Art Rejection

Claims 1, 4-9, 11, and 12 were rejected under 35 U.S.C. § 102(e) as anticipated by Litvinov (USP 6,656,613). Claims 1, 2, 4-9, and 11 were rejected under § 102(e) as anticipated by Maesaka (USP 6,596,418). Claims 1, 4-9, and 11-13 were rejected under § 103(a) as unpatentable over Litvinov. Finally, claims 10 and 20 were rejected under § 103(a) as unpatentable over Litvinov in view of Hanawa (USPGP 2002/0076579). Applicant traverses these rejections.

First, it appears that the examiner inadvertently maintained in the § 102(e) rejections based on each of Litvinov and Maesaka since each of these references would not have disclosed each and every claimed element.

Second, as to the rejection of claim 20, the examiner interpreted that the underlayer can contain other elements beside Ru. Claim 20 has been amended to define that the underlayer consists of ruthenium. Litvinov and Hanawa simply would not have disclosed or taught an underlayer consisting of ruthenium formed directly under the magnetic layer. Indeed, Litvinov does not even mention ruthenium in its disclosure. While Hanawa mentions ruthenium, it does so in conjunction with the magnetic layer composed of multi-layers including an antiferromagnetic layer 5c formed from ruthenium. Accordingly, applicant submits that Hanawa still would not have taught an underlayer composed of ruthenium since Hanawa's ruthenium layer is part of the magnetic layer.

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Rejoinder of Non-Elected Claims

As non-elected method claim 14 contains all of the elements of claim 20, if claim 1 is allowed, claim 14 **MUST** be rejoined and allowed together. In other words, per the decision in *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), if a method claim contains all of the elements of an allowed apparatus claim, then the method claim is allowable. See also MPEP § 821.04(b). Moreover, if claim 14 is allowed, then all claims depending from it are also allowable.

Conclusion

Applicant submits that the pending claims patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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20 OCTOBER 2005
DATE

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